

WILMERHALE

November 5, 2014

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**VIA ECF AND FACSIMILE**

Hon. Laura Taylor Swain  
United States District Judge  
Southern District of New York  
500 Pearl Street  
New York, NY 10007

Re: *Jay v. Spectrum et al.*, No.: 13-cv-8137-LTS-DCF  
List of Asserted Claims in which Each Disputed Claim Term Appears

Dear Judge Swain:

Pursuant to Your Honor's Order dated October 22, 2014 (DE 55), the parties hereby jointly submit a list of the asserted claims in which each disputed claim term ("DCT") appears:

**1. "Temporarily"**

- '542 Patent – claim 1
- '617 Patent – claims 1 and 35
- '316 Patent – claims 1, 9, 25, 29 and 39
- '308 Patent – claim 1
- '330 Patent – claims 1, 2, 3 and 5

**2. "Predetermined"**

- '542 Patent – claim 1
- '617 Patent – claims 1, 35 and 36
- '316 Patent – claims 1, 9, 25, 29 and 39
- '308 Patent – claim 1
- '330 Patent – claims 1, 2, 3, 5 and 7

**3. "Total Energy"**

- '542 Patent – claims 1, 5 and 6
- '617 Patent – claims 1, 3, 8, 35 and 36
- '316 Patent – claims 1, 3, 8, 9, 25, 27, 29, 32 and 39
- '308 Patent – claim 1
- '330 Patent – claims 1, 3, 5 and 7

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**4. “Projecting Hair [Fibers]”**

- ’542 Patent – claim 1
- ’316 Patent – claims 1, 39 and 42

**5. “Protruding Hair [Fibers]”**

- ’330 Patent – claims 1, 3, 4, 5, 6 and 7

**6. [“Growth of Hair” *or* “Hair Growth”] [Through *or* Along *or* At] “a Skin Surface”**

- ’542 Patent – claim 1
- ’617 Patent – claims 1, 35 and 36
- ’316 Patent – claims 1, 9, 29 and 39
- ’308 Patent – claim 1
- ’330 Patent – claims 1, 3 and 5

**7. “Prevent Hair Reappearance”**

- ’542 Patent – claim 1
- ’316 Patent – claims 25, 39 and 42
- ’308 Patent – claim 1
- ’330 Patent – claims 1 and 2

**8. “Prior to [a Visible] [Re]appearance of Hair[s] on [a *or* Said *or* “Along Said”] Skin Surface”**

- ’542 Patent – claim 1
- ’617 Patent – claims 1, 35 and 36
- ’316 Patent – claims 1, 25, 39 and 42
- ’308 Patent – claim 1
- ’330 Patent – claim 1

**9. [“Removal of” *or* Removing] [...] [“Projecting Hair” *or* “Projecting Hair Fibers” *or* “Protruding Hair Fibers”] “From [a *or* Said *or* “The Said”] Skin Surface”**

- ’542 Patent – claim 1
- ’316 Patent – claims 1, 25, 39 and 42
- ’330 Patent – claim 1

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**10. “Absorption of Light ... Resulting [in]” [“Temporary Removal of Hair From” *or* “Temporary Retardation of Hair Growth Along”] “Said Skin Surface”**

- ’617 Patent – claim 35
- ’316 Patent – claims 25 and 29

**11. “Maintain Said Skin Surface Temporarily Free of Projecting Hair Fibers”**

- ’316 Patent – claims 1 and 39

**12. [“Directing [Said *or* The] [...] Pulses [of Light] Toward[s] a” *or* “[Re]Apply[ing] [...] Pulses of Light To [a *or* Said *or* The]”] “Skin [Surface *or* Area]”**

- ’542 Patent – claim 1
- ’617 Patent – claims 1, 35 and 36
- ’316 Patent – claims 1, 25, 29, 30 and 39
- ’308 Patent – claim 1
- ’330 Patent – claims 1, 2, 3 and 5

**13. “Hair Removal Treatment”**

- ’330 Patent – claims 7 and 8

**14. “Temporarily Prevent[ing] [“Hair Reappearance” *or* “Reappearance of Hair”]**

- ’542 Patent – claim 1
- ’316 Patent – claims 25 and 39
- ’308 Patent – claim 1
- ’330 Patent – claims 1 and 2

**15. “Using Said Device To Temporarily Remove Hair From Said Skin Surface”**

- ’316 Patent – claim 25

**16. “To Temporarily Prevent [“a Growth of Hair” *or* “Hair Growth”] Through [a *or* Said] Skin Surface”**

- ’542 Patent – claim 1
- ’316 Patent – claims 9 and 39
- ’308 Patent – claim 1
- ’330 Patent – claims 1 and 3

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**17. “[For] The Temporary Removal of Hair”**

- ’316 Patent – claim 25
- ’330 Patent – claim 7

**18. “Irradiating the Skin Surface in a First Treatment Session to Prevent Hair Reappearance; and Thereafter and Prior to a Reappearance of Hair Fibers Along Said Skin Surface Irradiating the Skin Surface in a Second Treatment Session to Prevent Hair Reappearance”**

- ’316 Patent – claim 42

**19. “To Delay a Growth of Hair Through Said Skin Surface”**

- ’617 Patent – claim 36

To clarify, the parties stated at the October 22, 2014 Markman hearing that claim 19 did not need to be construed because it was not included in any of the asserted claims. Markman Hearing Tr., at 62:17-21. This was not correct. DCT 19 is recited in asserted claim 36 of the ’617 Patent.

**20. “Generating a [...] Predetermined Number of Pulses of Light”**

- ’542 Patent – claim 1
- ’617 Patent – claims 1, 35 and 36
- ’316 Patent – claim 1
- ’308 Patent – claim 1
- ’330 Patent – claim 1

**21. [“Said Pulses Having [...]” *or* “The ... Pulses of Light ... Each Include ... a” *or* “Each Light Application Including ...a”] [“Total Energy [all] Predetermined” *or* “[Predetermined] Total Energy”]**

- ’542 Patent – claim 1
- ’617 Patent – claims 1, 35 and 36
- ’316 Patent – claims 1, 9, 25, 29 and 39
- ’308 Patent – claim 1
- ’330 Patent – claims 1, 3, 5 and 7

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**22. “Directing [...] Said Pulses of Light Towards [a *or* Said] Skin Surface”**

- ’542 Patent – claim 1
- ’617 Patent – claims 1 and 36
- ’316 Patent – claims 1 and 39

**23. “Applying [Said] Pulses of Light to a Skin Surface”**

- ’617 Patent – claim 35
- ’316 Patent – claims 25 and 29
- ’308 Patent – claim 1

**24. “By Virtue of an Absorption of the Light of Said Pulses by Said Endogenous Chromophores in the Hair of Said Skin Surface, Effectuating Removal of Projecting Hair Fibers from Skin Surface”**

- ’316 Patent – claim 1

**25. “Prior to a Visible [Re]Appearance of Hair[s] on Said Skin Surface, [Again] Generating [...] Pulses of Light and Directing the [...] Pulses [...] Towards Said Skin Surface”**

- ’542 Patent – claim 1
- ’617 Patent – claim 1
- ’316 Patent – claims 1 and 39
- ’330 Patent – claim 1

**26. [Retard[ing] *or* Slow[ing] *or* “Diminution in a”] [“Hair Growth” *or* “Growth of Hair” *or* “Growth Rate of Hair”]**

- ’617 Patent – claims 1 and 35
- ’316 Patent – claims 1, 29 and 30
- ’330 Patent – claim 7

**27. “By Virtue of” [“the Directing of [...]” *or* “an Absorption of [...] Light”] “[...] Effectuating a Removal of Projecting Hair Fibers From Said Skin Surface”**

- ’542 Patent – claim 1
- ’316 Patent – claim 1

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**28. “By Virtue of [...] Absorption of Light [...] by Hair Fibers Below said Skin Surface”  
[“at Least Temporarily Retarding Hair Growth” or “Severing or Damaging the  
Hair Fibers”]**

- ’617 Patent – claims 35 and 36

**29. “Delay an Appearance of Hair on said Skin Surface”**

- ’617 Patent – claim 1

**30. “Sever or Destroy Hair Fibers Below [a or Said] Skin Surface”**

- ’617 Patent – claims 35 and 36
- ’316 Patent – claim 39

The parties respectfully request that the Court note that the language used in the above listing of DCT Nos. 6, 8-10, 12, 14, 16-17, 20-23, 25-27 and 30 has been revised (over the language stated in DE 39), to accurately track the language used in each of the above-cited asserted claims.

Respectfully Submitted,

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